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SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
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JUL 21 2008

OFFICE OF PETITIONS

In re Application of	:	
HARRY R. DAVIS	:	
Application No. 10/057,629	:	DECISION ON APPLICATION
Filed: January 25, 2002	:	FOR
Atty Docket No. CV01382K	:	PATENT TERM ADJUSTMENT

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)," filed August 30, 2007. Applicant requests correction of the patent term adjustment from 612 days to 921 days partly on the basis of the Office taking in excess of three years to issue the patent.

The request for reconsideration of the patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct patent term adjustment determination at the time of the mailing of the notice of allowance is **611 days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within three years. See 37 CFR 1.703(b). It is noted that at the time of this decision the patent has not issued.

Applicant is given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within three years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of 37 CFR 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

On June 25, 2007, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised that the patent term adjustment to date is 612 days. On August 30, 2007, applicant timely filed the instant request for reconsideration of the patent term adjustment.¹ Applicant directs the Office's attention to the filing of an Information Disclosure Statement (IDS) on May 10, 2005, after the filing of a notice of appeal on May 9, 2005, but before the filing of the appeal brief on June 6, 2005. Specifically, applicant asserts that the patent term adjustment should be reduced by one day for the period from the filing of the notice of appeal until the filing of the IDS in accordance with 37 CFR 1.704(c)(8).

The Office notes that the filing of the IDS on May 10, 2005, after the filing of the notice of appeal and before the filing of the appeal brief (i.e. during the period of perfecting the appeal), is not a circumstance that constitutes a failure to engage in reasonable efforts to conclude prosecution of the application within the meaning of 37 CFR 1.704(c)(8). Accordingly, the filing of the IDS on May 10, 2005, is not a supplemental reply or other paper within the meaning of 37 CFR 1.704(c)(8).

Nevertheless, a review of the application history reveals that the Office incorrectly entered the date of the final decision in favor of applicant by the Board of Patent Appeals and Interferences as March 1, 2007, instead of February 28, 2007. The date of February 28, 2007, and not March 1, 2007, should have been used in calculating patent term adjustment. Thus, the

¹ Office records indicate that the issue fee payment was received on September 24, 2007.

period of adjustment pursuant to 37 CFR 1.703(e) is 661 days, the number of days beginning on the date on which the notice of appeal to the Board of Patent Appeals and Interferences was filed, May 9, 2005, and ending on the date of a final decision in favor of applicant by the Board of Patent Appeals and Interferences, February 28, 2007.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is **611 days** (760 days of Office delay - 149 days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Applicant is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than three years after the filing date of the application that overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A) and 37 CFR 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

The application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

A handwritten signature in black ink, reading "Kery A. Fries". The signature is written in a cursive, flowing style.

Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of updated PAIR screen

Day : Sunday
Date: 7/20/2008**PALM INTRANET**

Time: 09:36:14

PTA Calculations for Application: 10/057629					
Application Filing Date:		01/25/2002	PTO Delay (PTO):		761
Issue Date of Patent:			Three Years:		0
Pre-Issue Petitions:		0	Applicant Delay (APPL):		149
Post-Issue Petitions:		0	Total PTA (days):		611
PTO Delay Adjustment:		-1			
File Contents History					
Number	Date	Contents Description	PTO	APPL	START
83	07/20/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		1	
74	06/25/2007	MAIL NOTICE OF ALLOWANCE			
73	06/21/2007	ISSUE REVISION COMPLETED			
72	06/21/2007	DOCUMENT VERIFICATION			
71	06/13/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
70	06/13/2007	CASE DOCKETED TO EXAMINER IN GAU			
69	06/11/2007	NOTICE OF ALLOWABILITY			
68	09/29/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
67	03/01/2007	MAIL BPAI DECISION ON APPEAL - REVERSED	662		47
66	02/28/2007	BPAI DECISION - EXAMINER REVERSED			
65.7	09/29/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
65	09/29/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
64	09/09/2006	ASSIGNMENT OF APPEAL NUMBER			
63	08/23/2006	APPEAL AWAITING BPAI DOCKETING			
61	08/10/2006	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
60	08/07/2006	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
59	05/03/2006	ORDER RETURNING UNDOCKETED APPEAL TO THE EXAMINER			
58	04/11/2006	APPEAL AWAITING BPAI DOCKETING			
56	08/30/2005	MAIL EXAMINER'S ANSWER			
55	08/22/2005	EXAMINER'S ANSWER TO APPEAL BRIEF			
		MAIL MISCELLANEOUS COMMUNICATION TO			

54	08/16/2005	APPLICANT			
53	08/15/2005	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
52	06/09/2005	DATE FORWARDED TO EXAMINER			
51	06/06/2005	APPEAL BRIEF FILED			
50	05/20/2005	MAIL ADVISORY ACTION (PTOL - 303)			
49	05/18/2005	ADVISORY ACTION (PTOL-303)			
48.7	05/10/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
48	05/10/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
47	05/09/2005	NOTICE OF APPEAL FILED		1	43
46	04/14/2005	DATE FORWARDED TO EXAMINER			
45	04/08/2005	AMENDMENT AFTER FINAL REJECTION			
44.7	04/08/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
44	04/08/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
43	02/08/2005	MAIL FINAL REJECTION (PTOL - 326)			
42	02/07/2005	FINAL REJECTION			
41	11/23/2004	DATE FORWARDED TO EXAMINER			
40	11/17/2004	RESPONSE AFTER NON-FINAL ACTION			
39	10/20/2004	MAIL NON-FINAL REJECTION			
38	10/18/2004	NON-FINAL REJECTION			
34	07/14/2004	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
33	07/14/2004	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
32	08/03/2004	DATE FORWARDED TO EXAMINER			
31	07/14/2004	RESPONSE AFTER NON-FINAL ACTION		29	27
30	07/14/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
29	07/14/2004	WORKFLOW INCOMING PETITION IFW			
28	07/14/2004	WORKFLOW INCOMING AMENDMENT IFW			
27	03/15/2004	MAIL NON-FINAL REJECTION			
26	03/03/2004	NON-FINAL REJECTION			
25	12/01/2003	REFERENCE CAPTURE ON IDS			
24.7	12/01/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		10	20
		INFORMATION DISCLOSURE STATEMENT (IDS)			

24	12/01/2003	FILED			
23	01/14/2004	CASE DOCKETED TO EXAMINER IN GAU			
22	12/09/2003	IFW AMENDED CASE PROCESSING COMPLETE			
21	12/09/2003	DATE FORWARDED TO EXAMINER			
20	11/21/2003	RESPONSE TO ELECTION / RESTRICTION FILED		109	15
19	10/31/2003	REFERENCE CAPTURE ON IDS			
18.7	10/31/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
18	10/31/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
17	10/21/2003	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
16	08/13/2003	DATE FORWARDED TO EXAMINER			
15.1	08/04/2003	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
15	08/04/2003	RESPONSE TO ELECTION / RESTRICTION FILED			
14	07/02/2003	MAIL RESTRICTION REQUIREMENT	99		-1
13	06/30/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
12.7	06/09/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
12	06/09/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11.7	05/16/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11	05/16/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10.7	05/05/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	05/05/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9.7	04/14/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	04/14/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
8.7	01/13/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
8	01/13/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
7.7	08/23/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
7	08/23/2002	INFORMATION DISCLOSURE STATEMENT (IDS)			

		FILED			
6	09/04/2002	CASE DOCKETED TO EXAMINER IN GAU			
5.7	08/21/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
5	08/21/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
4	02/25/2002	APPLICATION DISPATCHED FROM OIPE			
3	02/20/2002	APPLICATION IS NOW COMPLETE			
2	02/06/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	01/25/2002	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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